

REMARKS

In response to the Office Action dated 20 June 2003, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-25 are pending in the application, and are rejected. Claims 1, 3, 7, 8, 12, 13, 17, 21, and 23 will be amended, and claims 24-25 will be cancelled, upon entry of the present amendment.

Telephone Interview

The applicant thanks Examiners Lee and Auve for the telephone interview granted on Tuesday, 9 September 2003, between themselves and the applicant's representative Mr. Mates (Reg. No. 35,271). The applicant filed an Interview Summary on 13 October 2003.

Information Disclosure Statement

The applicant filed an Information Disclosure Statement with a single sheet of Form 1449 on 8 March 2001. A copy of the Form 1449 was returned to the applicant with the Office Action dated 20 June 2003, but the U.S. Patent Documents listed thereon were not initialed by the Examiner as being considered. The applicant respectfully requests that all of the references listed on the Form 1449 be considered by the Examiner. Pursuant to the provisions of MPEP 609, the applicant requests that a copy of the Form 1449 filed on 8 March 2001, with all of the listed references initialed as being considered by the Examiner, be returned to the applicant with the next official communication.

Amendments to the Claims

Claims 3, 12, 13, 17, and 23 are amended herein to correct matters of form only, and were not amended in response to the rejections in the Office Action. The amendments to claims 3, 12, 13, 17, and 23 are not narrowing amendments.

Objections

Claims 13, 24, and 25 were objected to. Claim 13 will be amended and claims 24 and 25 will be cancelled upon entry of the present amendment to obviate the objection.

Rejection of Claims Under §102

Claims 1-4 and 11 were rejected under 35 USC § 102(a) as being anticipated by Yaguchi et al. (JP 2000-231969, Yaguchi). The applicant respectfully traverses.

Claim 1 will be amended upon entry of the present amendment to include features recited in original claim 7 which was rejected under 35 USC § 103(a). The applicant will address this rejection with respect to the rejection of original claim 7 below. Claims 2-4 and 11 depend on amended claim 1, and recite further limitations with respect to amended claim 1.

Claims 21-23 were rejected under 35 USC § 102(e) as being anticipated by Tsai (U.S. Patent No. 6,283,789). The applicant respectfully traverses.

Claim 21 will be amended upon entry of the present amendment to include features recited in original claim 25 which was rejected under 35 USC § 103(a). The applicant will address this rejection with respect to the rejection of original claim 25 below. Claims 22-23 depend on amended claim 21, and recite further limitations with respect to amended claim 21.

Rejections of Claims Under §103

Claims 7 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai. The applicant respectfully traverses.

Yaguchi was published on 22 August 2000, which less than one year before the 5 December 2000 filing date of the present application. The applicant does not admit that Yaguchi is prior art, and reserves the right to swear behind Yaguchi at a later date.

Tsai issued on 4 September 2001, which is after the 5 December 2000 filing date of the present application. The applicant does not admit that Tsai is prior art, and reserves the right to swear behind Tsai at a later date.

Features of original claim 7 have been added to independent claim 1 that will be amended upon entry of the present amendment, and this rejection will now be addressed with respect to amended claim 1. Amended claim 1 recites an apparatus, comprising, among other elements, a downstream receptacle connected to both a power supply and a bus hub.

The MPEP states the following with regard to rejections under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art. MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The Federal Circuit has emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness....The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

“when they [the examiner and the Board] rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record....The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.” *In re Lee*, 61 USPQ2d at 1435.

The Office Action has not provided sufficient evidence to support the rejections of claim 7, now rewritten in independent form in claim 1, under 35 USC § 103.

Yaguchi relates to a USB hub, and as the Office Action states, Yaguchi “does not teach a downstream receptacle connected to both the power supply and the bus hub.” Office Action, page 5. Tsai relates to a data and power transmitting cable system. The Office Action states that system 100 of Figure 18 and col. 3, lines 51-56 of Tsai “implies that said downstream receptacle connected to both a power supply and a bus hub.” Office Action, pages 5-6. The applicant respectfully submits that Tsai does not teach or suggest a downstream receptacle connected to both the power supply and the bus hub as is recited in amended claim 1. To repeat the MPEP quote above, “to establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143. The

rejection of original claim 7, now rewritten in independent form as claim 1, is not supported by objective evidence of record as is required by *In re Lee*.

The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of amended claim 1, and that amended claim 1 is in condition for allowance.

Claims 2-4, 8, and 11 depend on amended claim 1, and recite further limitations with respect to amended claim 1. For reasons analogous to those stated above, and the limitations in the claims, the applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 2-4, 8, and 11, and that claims 2-4, 8, and 11 are in condition for allowance.

Claims 5 and 6 were rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Urade et al. (U.S. Patent No. 6,272,644, Urade). Claim 9 was rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai and Decuir (U.S. Patent No. 5,781,028). Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Yaguchi in view of Tsai and Sanchez (U.S. Patent No. 6,446,867). The applicant respectfully traverses.

Claims 5, 6, 9, and 10 depend on amended claim 1, and recite further limitations with respect to amended claim 1. For reasons analogous to those stated above, and the limitations in the claims, the applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 5, 6, 9, and 10, and that claims 5, 6, 9, and 10 are in condition for allowance.

Claims 12, 13, 16, 17 and 19 were rejected under 35 USC § 103(a) as being unpatentable over Shimazaki (U.S. Patent No. 6,338,143) in view of Yaguchi and Tsai. The applicant respectfully traverses.

Shimazaki issued on 8 January 2002, which is after the 5 December 2000 filing date of the present application. The applicant does not admit that Shimazaki is prior art, and reserves the right to swear behind Shimazaki at a later date.

Shimazaki relates to an electronic device including a power supply circuit, and as the Office Action states, "Shimazaki does not disclose a power hub." Office Action, page 8. Yaguchi relates to a USB hub. The Office Action stated that it would have been obvious to include the hub of Yaguchi in the device of Shimazaki and cited Yaguchi, column 1, paragraph 6 as evidence supporting the rejection. The applicant notes that Yaguchi is a publication of a Japanese application, and that the text on which the rejection is based, column 1, paragraph 6 of Yaguchi, is written in Japanese.

37 CFR § 1.52(b)(1)(ii) requires that the application and any amendments to the application be in the English language or be accompanied by a translation into English with a statement that the translation is accurate. The applicant concludes from 37 CFR § 1.52(b)(1)(ii) that the PTO is under a corresponding duty to conduct business in the English language with applicants. The applicant respectfully submits that this duty of the PTO extends to providing a translation of a Japanese reference into English when that Japanese reference is relied on as evidence of obviousness in a rejection of claims under §103. Furthermore, in an analysis of patentability under §103, "a prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention." *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

The applicant respectfully concludes from the foregoing that the PTO is obliged to provide to applicant a translation of the whole of Yaguchi into the English language with a statement that the translation is accurate. The applicant respectfully requests that such a translation be provided the applicant, or the rejection be withdrawn. Absent a translation of Yaguchi into the English language, the applicant respectfully submits that the rejection of amended claim 12 is not supported by objective evidence of record as is required by *In re Lee*.

The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of amended claim 12, and that amended claim 12 is in condition for allowance.

Claims 13, 16, 17 and 19 depend on amended claim 12, and recite further limitations with respect to amended claim 12. For reasons analogous to those stated above, and the limitations in the claims, the applicant respectfully submits that the Office Action has not established a *prima*

facie case of obviousness of claims 13, 16, 17 and 19, and that claims 13, 16, 17 and 19 are in condition for allowance.

Claim 14 was rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Decuir. Claim 15 was rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Sanchez. Claims 18 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Shimazaki in view of Yaguchi, Tsai, and Urade.

Claims 14, 15, 18 and 20 depend on amended claim 12, and recite further limitations with respect to amended claim 12. For reasons analogous to those stated above, and the limitations in the claims, the applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 14, 15, 18 and 20, and that claims 14, 15, 18 and 20 are in condition for allowance.

Claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Tsai in view of Decuir. Claim 24 will be cancelled upon entry of the present amendment.

Claim 25 was rejected under 35 USC § 103(a) as being unpatentable over Tsai in view of Sanchez. The applicant respectfully traverses.

Claim 21 will be amended upon entry of the present amendment to recite a cable comprising, among other elements, a fiber optic channel. This feature was added to amended claim 21, and claim 25 will be cancelled upon entry of the present amendment. This rejection will be addressed with respect to amended claim 21.

The rejection is based on a combination of Tsai and Sanchez, and the Office Action states that "it would have been obvious....to have used said fiber optic channel....by Sanchez, for signal wires, as disclosed by Tsai, for the advantage of ...communicating high aped digital signals...without spreading electromagnetic noise." Office Action, page 12. The Office Action cited col. 1, lines 57-60 of Decuir (the applicant assumes this meant Sanchez) which does not appear to mention "without spreading electromagnetic noise."

The applicant respectfully submits that the rejection of original claim 25, now rewritten in independent form as claim 21, is not supported by objective evidence of record as is required by *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of amended claim 21, and that amended claim 21 is in condition for allowance.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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By his Representatives,

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Date 20 November 2003

By 
Robert E. Mates
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Non-Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of November, 2003.

Anne M. Richards

Name



Signature